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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,377	11/22/2005	Joanne Tran-Guyon	19170-002US1 FR03/03205 U	4768
26161	7590	11/16/2007	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			SOLOLA, TAOFIQ A	
			ART UNIT	PAPER NUMBER
			1625	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/533,377

Applicant(s)

TRAN-GUYON ET AL.

Examiner

Taofiq A. Solola

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 23-54 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 23-54 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

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Claims 23-54 are pending in this application.

Claims 1-22 are cancelled.

DETAILED ACTION

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 27-28, 31-43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The phrases "organic acid ester", claim 27, last line and "ester of an aliphatic or aromatic organic acid", claim 38, line 5, are not defined in the specification so as to ascertain structures of the compounds included and/or excluded by the phrases. Therefore, claims 27-28, 31-43 lack adequate support in the specification. The only esters disclosed in the specification are compounds of formula IV of claim 29. This cannot be read into claims 27-28, 31-43 in contradiction of several precedent decisions by the US courts and official practice. A claim must stand alone to define the invention, and incorporation into the claims by reference to the specification or an external source is not permitted. *Ex parte Fressola*, 27 USPQ 2d 1608, BdPatApp & Inter. (1993). In patent examination, it is essential for claims to be precise, clear, correct, and unambiguous. *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

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Claims 26-46, 51-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For the reason set forth above under 35 USC 112, first paragraph, claims 27-28, 31-43 are indefinite.

The structure of fluorescein has phthalein not the other way round. Therefore, claim 26 is confusing and indefinite. Appropriate correction is required.

The compounds in claim 30 are not acid esters, while some compounds in claim 29, e.g. "aryloxy", "aryl ester", "alkyl ester" and "alkoxy" cannot be R7 in formula IV. If they are R7 the resulting compounds would not be within the scope of formula IV. By deleting the claims the rejection would be overcome.

Claim 36 as written is not clear and therefore indefinite. The starting reagent in claim 35 is the product of claim 27. How can the product of 35 be the same as in 27? By deleting the claim the rejection would be overcome.

Claims 38, 44-46 refer to figures in the specification. This is not allowed under the US patent practice. Therefore, claims 38-40, 42, 44-46 are indefinite. See *Ex parte Fressola*, supra.

Claims 44-45 are duplicates of claim 1. Something old or obvious does not become new upon discovery of new properties, functions or utilities, *In re Best*, 562 F.2d 1252; 195 USPQ 430 (CCPA, 1977). Under the US patent practice duplicates or substantial duplicate claims cannot be in the same application. By deleting the claims the rejection would be overcome.

Claims 52-54 are duplicates of 51. Under the US patent practice intended use is not a limitation of a compound or product. *In re Hack*, 114 USPQ 161 (CCPA, 1957); *In re Craig*, 90 USPQ 33 (CCPA, 1951); *In re Brenner*, 82 USPQ 49 (CCPA, 1949). By deleting the claims the rejection would be overcome.

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Applicant should note that the requirement of 35 USC 112, is not what is obvious to one of ordinary skill in the art but a "full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same", *Lookwood v. American Airlines Inc.* 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed Cir. 1997).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 45-46, 49-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Monsanto DE 360691.

Monsanto discloses gallein made by condensing phthalic anhydride with pyrogallol. See the translated summary. The product is assumed to have no more than 0.2 to 1% of impurities by weight absent a showing to the contrary. Claims 49-50 are product-by-process. Patentability of product-by-process claim is based on the product itself. Though, the claims are limited and defined by their process of making, the products are unpatentable if they are the same or obvious from the product of a prior art. *In re Thorpe*, 227 USPQ 964 (CAFC, 1985). See also *Ex parte Gray*, 10 USPQ 2d 1922.

Claims 23-26, 44, 47-48, 51-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Sujeeth, US 5,637,733.

Sujeeth discloses fluorescein compounds of formula I and composition thereof. The compounds have few substituents R and R', there are limited alternative points of attachments

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of the substituent to the parent structural nuclei, which does not change. Therefore, Sujeeth "has described to those of ordinary skill in [the] art each of the various permutations involved . . . as fully as if [he] had drawn each structural formula or had written each name." *In re Petering*, 133 USPQ 275 (CCPA 1962).

The products are assumed to have no more than 0.2 to 1% of impurities by weight absent a showing to the contrary. Claims 47-48 are product-by-process. Patentability of product-by-process claim is based on the product itself. Though, the claims are limited and defined by their process of making, the products are unpatentable if they are the same or obvious from the product of a prior art. *In re Thorpe*, 227 USPQ 964 (CAFC, 1985). See also *Ex parte Gray*, 10 USPQ 2d 1922. Intended use in claims 51-54 is not a limitation. See *Hack*, *supra*.

Claims 23-26, 44, 47-48, 51-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Burdette et al., J. Am. Chem. Soc. (2001), Vol 123, pp. 7831-7841.

Burdette et al., disclose compounds 1-4 and their compositions. See page 7836. The product is assumed to have no more than 0.2 to 1% of impurities by weight absent a showing to the contrary. Claims 47-48 are product-by-process. Patentability of product-by-process claim is based on the product itself. Though, the claims are limited and defined by their process of making, the products are unpatentable if they are the same or obvious from the product of a prior art. *In re Thorpe*, 227 USPQ 964 (CAFC, 1985). See also *Ex parte Gray*, 10 USPQ 2d 1922. Intended use in claims 51-54 is not a limitation. See *Hack*, *supra*.

Claims 23-26, 44, 47-48, 51-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Singh, US 6,514,700.

Singh discloses compounds in columns 23-28 and their compositions. The product is assumed to have no more than 0.2 to 1% of impurities by weight absent a showing to the

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contrary. Claims 47-48 are product-by-process. Patentability of product-by-process claim is based on the product itself. Though, the claims are limited and defined by their process of making, the products are unpatentable if they are the same or obvious from the product of a prior art. *In re Thorpe*, 227 USPQ 964 (CAFC, 1985). See also *Ex parte Gray*, 10 USPQ 2d 1922. Intended use in claims 51-54 is not a limitation. See *Hack*, supra.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23-26, 44-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monsanto DE 360691; Sujeeth, US 5,637,733; Singh, US 6,514,700; and Burdette et al., J. Am. Chem. Soc. (2001), Vol 123, pp. 7831-7841, individually.

Applicant claims compounds of formula I and compositions thereof. In preferred embodiments, the compounds are claimed as product-by-process and the composition with intended uses.

Determination of the scope and content of the prior art (MPEP §2141.01)

The prior arts teach compounds and their compositions as above.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the instant invention and that of the prior arts is that applicant claims alkyl instead of H by the prior arts at positions R1-R5.

Finding of prima facie obviousness---rational and motivation (MPEP §2142.2413)

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However, H and alkyl are art recognized equivalents. *In re Lincoln*, 53 USPQ 40 (CCPA, 1942); *In re Druey*, 319 F.2d 237, 138 USPQ 39 (CCPA, 1963); *In re Lohr*, 317 F.2d 388, 137 USPQ 548 (CCPA, 1963); *In re Hoehsema*, 399 F.2d 269, 158 USPQ 598 (CCPA, 1968); *In re Wood*, 582 F.2d 638, 199 USPQ 137 (CCPA, 1978); *In re Hoke*, 560 F.2d 436, 195 USPQ 148 (CCPA, 1977); *Ex parte Fauque*, 121 USPQ 425 (POBA, 1954); *Ex parte Henkel*, 130 USPQ 474, (POBA, 1960).

When the difference between compounds is the length of a carbon chain such are adjacent homologs. However, adjacent homologs are prima facie obvious. *In re Henze*, 85 USPQ 261 (1950).

Therefore, the instant invention is prima facie obvious from the teachings of the prior arts. One of ordinary skill in the art would have known to replace H with alkyl and claim adjacent homologs at the time the instant invention was made. The motivation is from the knowing that H and alkyl are equivalents, and that adjacent homologs would have similar biological and/or chemical properties.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD., whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached on (571) 272-0867. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

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A handwritten signature in black ink, appearing to read 'Taofiq Solola', with a stylized, overlapping flourish at the beginning.

TAOFIQ SOLOLA
PRIMARY EXAMINER

Group 1625

November 11, 2007